

REMARKS

I. Status of claims

Claims 37, 40-45, and 47-50 are pending in this application. By this Amendment, claims 37 and 44 have been amended, and claim 38 has been canceled. Applicant's specification fully supports these amendments. Reconsideration is respectfully requested in view of the above amendments and the following remarks.

II. Claim Rejections under 35 U.S.C. §103(a)

Claims 37, 38, 40-45, and 47-50 have been rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,070,153 to Simpson in view of Maki, Dee Ann, "*AmEx takes the Cobranding Plunge*", (hereinafter "Maki") and "*The new cobrand wisdom: mine your backyard*" in Credit Card News (hereinafter "Credit Card News"). This rejection is respectfully traversed.

Even if combined, Simpson, Maki, and Credit Card News fail to disclose the features of independent claims 37 and 44. In summary, the Office Action fails to establish a *prima facie* case of obviousness. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143.

Simpson discloses a system in which a card issuer offers an investment account to customers having credit accounts. Simpson provides applicants with two applications, one for a credit account and one for an investment account (See Fig. 1, steps 1, 2A, and 3). Multiple funding arrangements for the investment account are offered in Simpson and these funding arrangements may be combined. All of the funding arrangements are funded by either the cardholder or the card issuer. However, those arrangements funded by the cardholder are

controlled by the card issuer, in that deposits made to the investment account are pre-arranged and accomplished through the card issuer.

Maki discloses co-branding, and more specifically, the sharing of card space with co-branding partners. Credit Card News discloses a shared funding arrangement in which a merchant (Bell Atlantic) shares funding of rewards with the credit card issuer (Chase).

Even if combined, Simpson, Maki, and Credit Card News fail to disclose all of the features of independent claims 37 and 44. With respect to claim 37, which requires a computerized method for implementation of multiple accounts, the references fail to show multiple features. None of the references discloses a first set of features (I) including providing an investment fund card application to an applicant, the investment fund card application entitling an approved cardholder to establish a card payment instrument account and an investment account, approving a submitted investment fund card application, and establishing the card payment instrument account through the card issuer for the approved cardholder upon approval, wherein the card payment instrument account includes a reward feature available to the cardholder. The references further fail to show automatically creating the investment account for the approved cardholder through the financial institution upon approval of the investment fund card application.

Specifically, Simpson fails to disclose an investment fund card application. Simpson discloses two separate applications, one for an investment fund and another for a credit card.

As noted in the Office Action, Simpson also fails to disclose a second set of features (II) including issuing a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial institution and the name of the card issuer. The Office Action also recognizes that Simpson fails to disclose a third set of features (III) including

establishing a reward structure through an agreement between the financial institution and the card issuer, wherein funding of the reward feature is shared between the financial institution and the card issuer. Finally, with respect to currently pending claim 37, Simpson further fails to disclose a fourth set of features (IV) including allowing independent funding of the investment account by the cardholder.

Maki and Credit Card News fail to obviate the deficiencies of Simpson. Specifically, neither of these references discloses feature set (II) above including a credit card bearing two names including the name of a financial institution and that of a credit card issuer as required by claim 37. Instead, Maki merely discloses that co-branding partners may cause both names to appear on a credit card. Furthermore, neither Credit Card News nor Maki discloses shared funding of rewards between a financial institution and a credit card issuer as required by feature set (III) above. Instead, Maki merely discloses that a merchant may jointly finance rewards by providing some of its services or goods. Finally, neither Maki nor Credit Card News discloses any information relevant to feature set (I) or (IV) above.

Furthermore, Simpson teaches away from a method including establishment of a reward structure through an agreement between the financial institution and the card issuer, wherein funding of the reward feature is shared between the financial institution and the card issuer. "It is improper to combine references where the references teach away from their combination." *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). As illustrated in FIG. 3 and as explained in the Simpson specification, multiple funding methods are possible. All of these funding methods involve either card issuer funding, cardholder funding, or a combination of both methods.

Thus, because the references, even if combined, fail to disclose the features of the invention of claim 37 and further because no motivation, teaching, or suggestion has been provided for arriving at the combination of features, the Office Action has failed to establish a *prima facie* case of obviousness. Likewise, dependent claims 40-43 depend from claim 37 and therefore define over the art of record for the reasons set forth above with respect to claim 37.

Independent claim 44 defines over Simpson, Maki, and Credit Card News for similar reasons. Specifically, the combination of references fails to disclose simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution by providing an investment card application. The references collectively further fail to disclose that when a recipient of an offer for multiple accounts accepts the offer for multiple accounts by completing the investment card application, the card payment instrument account is established in response to the acceptance. The references further fail to disclose automatically creating the investment account in response to the acceptance by notifying the financial institution to create the investment account upon issuance of the card payment instrument account by the card issuer. The references additionally fail to disclose issuing a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial institution and the name of the card issuer and establishing a reward structure through an agreement between the financial institution and the card issuer, wherein funding of the reward feature is shared between the financial institution and the card issuer.

Accordingly, for at least the reasons set forth above, the references fail to render obvious claim 44. Dependent claims 45 and 47-50, define further distinctive features of the invention and define over the art of record for at least the reasons set forth above with respect to claim 44.

Applicants respectfully traverse and request withdrawal of this rejection under 35 U.S.C. §103 as it may be applied to the currently pending claims.


III. Conclusion

As set forth above, applicant respectfully submits that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicants have overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Respectfully submitted,

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